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D. REMARKS

Responsive to Examiner's Detailed Action item 2, Applicants exercise option to file a reply under 37 CFR 1.111.

Applicants' attorney appreciates the opportunity to have had an interview with the Examiner on November 10, 2004. Applicants' attorney presented the option to file a Terminal Disclaimer concerning both the instant application and copending patent application No. 09/843,059. Concerning the instant application, Applicant's clarifications of claim 1 elements were discussed, including Examiner's suggestion to Applicants to amend the second element of claim 1 to read: "storing each captured screen image of the multimedia object, in a chronological list" in order to distinctly claim that it is not the complete screen image that is being stored, but the area covered by the multimedia object. In addition, a common understanding was arrived at on the meaning of the term "rendered" as used in the claim. Also discussed were Examiner's references cited in the Office Action, and Applicants' attorney particularly pointed out how the teachings of Olah in combination with Pavley do not teach or suggest the claimed display of the chronological list of multimedia objects.

Responsive to Examiner's Detailed Action item 4, the title of the invention is amended herein.

Responsive to Examiner's Detailed Action item 5, objection of claims 8 and 22, Applicants herein correct claims 8 and 22 via current claims amendment.

Responsive to Examiner's provisional rejection of claims 1, 18, 28 and 33-35

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(Detailed Action item 7), as will be shown below, Applicants respectfully submit that the subject matter claimed in the instant application is not fully disclosed in the copending application No. 09/843,059, nevertheless a Terminal Disclaimer is herein included.

Responsive to Examiner's Detailed Action item 9, Applicants confirm that the subject matter of the instant claims was commonly owned at the time of invention.

Claims 1, 2, 4-10, 18-24, 27-30, 33-35 remain pending herein.

Claims 3, 11-17, 25, 26, 31 and 32 have been previously canceled.

Claim Rejections – 35 U.S.C. § 103

Claims 1-2, 4-6, 18-20, 28 and 33-35 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Olah et al. ("Olah", US 6446,119 B1) in view of Pavley et al. ("Pavley", US6,317,141 B1). Applicants respectfully traverse each rejection, and submit that Examiner's rejections are overcome with the previous responses, and as clarified herein. To establish a prima facie case of obviousness, three basic criteria must be met.[1] First, the combination must teach or suggest all of Applicant's claim limitations.[2] Second, there must be a suggestion or motivation to combine the references.[3] Finally, there must be a reasonable expectation of success in the combination.[4]

Olah and Pavley

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[1] Manual of Patent Examining Procedure §2142.
[2] *In re Royka,* 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).
[3] *In re Vaeck,* 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).
[4] *In re Merck & Co., Inc.,* 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986).

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Claims 1-2, 4-6, 18-20, 28 and 33-35 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Olah in view of Pavley. The combination of Olah and Pavley cannot establish a prima facie case of obviousness because the proposed combination does not teach or suggest each and every element of Applicants' pending claims, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

<u>Neither Olah nor Pavley, Alone Or In Combination,</u>
<u>Teach Or Suggest All Of Applicant's Claim Limitations</u>

Neither Olah nor Pavley, alone or in combination, teach or suggest all of Applicant's claim limitations. Concerning rejection of Applicants' claim 1, Examiner stated that Olah teaches Applicants' claimed element "storing each captured screen image in a chronological list." Examiner submitted that Olah teaches this element at Olah, (Col. 4, lines 32-33, log) Applicants submit that Olah does not teach or suggest Applicants' claim element, and instead teaches away from Applicants' claimed invention.

<u>Olah Does Not Teach Or Suggest Applicants' Claimed Invention</u>

Olah teaches that "an entire hour's worth of activity may be displayed on the terminal 5A, each image being **reduced in size and resolution to fit**" (Col. 9, lines 29-31). In contrast, the present invention provides "**a subsequent rendering** of the stored screen captured images" and not a reduced image as taught by Olah.

Examiner stated that Olah does not explicitly disclose Applicants' claimed invention of "displaying the chronological list with control buttons for enabling a subsequent rendering of the stored screen captured images in at least one of a forward and backward succession, at a user configurable rate, in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with

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initially rendering a given multimedia object from which the screen images were captured."
Examiner stated that "Pavley discloses creating a slide show for the captured multimedia objects
(Pavley, col. 2, lines 15-20). A slide show such as Microsoft PowerPoint displays a list of
multimedia objects in a forward succession at a user configurable rate." Applicants submit that
Pavley does not teach or suggest Applicants' claimed invention.

Pavley Does Not Teach Or Suggest Applicants' Claimed Invention

Pavley teaches that "a user may import the images, and video directly into a presentation program
such as Microsoft PowerPoint" (Col. 2, Lines 15-20). Nowhere does Pavley teach or suggest creating a
slide show for "displaying the **chronological list** with control buttons…" as claimed by Applicants.
Instead, Pavley teaches "a method… for creating and presenting a multimedia
presentation…accomplished by navigating through several displays…**selecting and marking** the
desired objects in the preferred order to create an ordered list of objects, and then saving the ordered
list of objects as a slide show" Col. 8, Lines 50-62). Pavley does not teach or suggest "displaying the
chronological list…" as claimed by applicants, and instead teaches away by navigating through
several displays, selecting and marking the desired objects in the preferred order, and not displaying
the chronological list as claimed by applicants.

Furthermore, Pavley teaches "three types of duration settings" (Col.16, Line 67, Col 17,
Line 1) for specifying for each object "the duration **the media object** will be played back" (Col. 15,
Lines 65-67). The specified duration of playback in Pavley is for each individual media object, and
not "the chronological list…of screen captured images…at a user configurable rate" as claimed by
Applicants, thus teaching away from Applicants claimed invention.

In addition, Pavley teaches that "play mode causes each of the media objects included in the
slide show to be individually played back on the display screen 140 in the sequence they were
marked without user intervention" (Col. 11, Lines 57-65) thus, teaching away from "displaying
the **chronological list** with control buttons for enabling subsequent rendering of the stored screen
captured images…" as claimed by Applicants.

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Pavley teaches "in the case of slide show 360 created as metadata file, the slide show is played...**in the order listed in the file**" (emphasis added) (Col. 11, Line 66-Col. 12, Line 5). Thus, Pavley does not teach Applicants' claimed invention, and instead teaches away from "displaying the **chronological list** with control buttons for enabling a subsequent rendering of the stored screen captured images,...wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given multimedia object from which the screen images were captured."

Moreover, Pavley teaches user defined events for presentation styles of slide show. "The first presentation style is to play back the media objects in the **order that they were marked** by the user during slide show creation" (emphasis added) (Col. 15, Lines 12-15). In Pavley "the second presentation style is **random access**, where the play back is controlled manually by the user" (emphasis added) (Col. 15, Line 19). Pavley teaches "the third presentation style is **branching**...During playback the user controls whether or not the branch should be taken" (Col. 15, Lines 39-43). Pavley teaches editing of the branch properties, so that "during playback, the user controls whether or not the branch should be taken." Thus, during the slide show, the sequence of displaying the objects is either a marked sequence, a random sequence, or a branching sequence. Nowhere does Pavley teach or suggest a slide show of a **chronological list** of the stored screen captured images, and instead teach away from "displaying the chronological list" as claimed by Applicants.

The Combination of Olah and Pavley Does Not Teach Or Suggest Applicants' Claimed Invention

Examiner stated that "a slide show sequentially displays all the captured screen images" (Office Action Page 5). However, Pavley is silent on displaying a "**chronological list**" as claimed by Applicants. Furthermore, any proposed slide show as taught by Pavley would be for images, and not for the "stored activity log" as taught by Olah. In addition, there is no teaching either in Olah or Pavley alone or in combination that would teach or suggest displaying "the chronological list with

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control buttons...at a user configurable rate...wherein the displayed control buttons are independent of any playback control..." as claimed by Applicants.

No Suggestion or Motivation to Modify or to Combine Olah with Pavley

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify Olah, or to combine Olah with Pavley. *In re Vaeck,* 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Absent such a showing of suggestion or motivation, the Examiner has impermissibly used "hindsight" occasioned by Applicant's own teaching to reject the claims. *In re Surko,* 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck,* 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman,* 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond,* 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski,* 871 F,.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Examiner concludes, "Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a slide show presentation to display the captured multimedia objects in the system of Engle [Olah, sic]. A slide show sequentially displays all the captured screen images so that the user does not need to select and play the multimedia object one at a time. It is much convenient for the user." (Office Action, page 5). There is no support in either reference for such a conclusion. In fact, as pointed out above, Olah explicitly teaches away from such storing and rendering independent of user action, a chronological list of captured screen images and Pavley teaches away from creating a slide show presentation that displays the chronological list as claimed by applicants.

Therefore, there is no suggestion or motivation to modify either Olah or Pavley, in order to combine Olah and Pavley to produce Applicants' claimed invention.

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There Is No Reasonable Expectation Of Success In The Proposed Combination Of Olah And Pavley.

There is no motivation to modify or combine Olah with Pavley to produce Applicants' claimed invention because the proposed combination would change the principle of operation of Olah, and would render Olah unsatisfactory for its intended purpose. Since Olah's principle of operation is to prevent the user from knowing about the monitoring action, and to restrict that knowledge about and access to the activity log, then that same user would be prevented from using a slide show as taught by Pavley, and this would render Olah unsatisfactory for its intended purpose if combined with Pavley which would **display** a slide show of a stored activity log. Furthermore, there is no motivation to modify or combine Olah with Pavley to produce Applicants' claimed invention because the proposed combination would change the principle of operation of Pavley, and would render Pavley unsatisfactory for its intended purpose. Since Pavley's principle of operation is for creating, editing and presenting a multimedia presentation of media objects, if combined with Olah, the slide show would not be able to be displayed by the user since Olah would prevent disclosure of knowledge to the computer user about the stored activity log, thus Pavley would not have any knowledge of an activity log to show in a slide show. Therefore, There is no reasonable expectation of success in the proposed combination of Olah and Pavley.

Olah teaches a system and method for monitoring computer usage. Olah teaches that "although it is unlikely, it is possible a user could discover the occurrence of the monitoring event" (Col. 8, lines 5-6), and "for security purposes, e.g., to prevent ... accessing or modifying the log, this option preferably activates a password screen" (Col. 7, lines 4-6). Thus Olah attempts to hide the monitoring process of capturing screen shots from the computer user because that activity is unlikely to be known by the computer user, and restricts the access and display of the stored log from the

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user. Thus, the display of the activity log as taught by Olah allowing a user to display a slide show as taught by Pavley, and defeats the purpose of Olah since the activity log would be displayed.

Thus, Applicants submit that there is no suggestion or motivation to combine Olah and Pavley to produce Applicant's claimed invention because the combination of the teachings of Olah and Pavley render both the Olah and Pavley teachings unsatisfactory for their intended purpose. *In Re Tatti*, 270 F2d 810, 123 USPQ 349 (CCPA 1959), *in re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Therefore, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness under 35 USC 103(a) with respect to claim 1. Withdrawal of the rejection of claim 1 is respectfully requested.

Responsive to Examiner's rejection of dependent claims 2, 4, 5 and 6 Applicants respectfully submit that the Examiner has not proven prima facie obviousness for claim 1, and therefore dependent claims 2, 5 and 6 which depend from claim 1 should be allowed.

Responsive to Examiner's rejection of claims 18-20, 28 and 33-35, Applicant's response is similar to Applicant's response made for corresponding claims 1-2 and 4-6. Therefore, Applicant respectfully submits that the Examiner has not proven prima facie obviousness for claims 1-2 and 4-6, and therefore corresponding claims 18-20, 28 and 33-35 should be allowed.

The Combination of Olah, Pavley And Asai Does Not Teach Applicants Invention

In view of Applicants' response with regards to claim 1, Applicants respectfully submit that the combination of Olah and Pavley does not teach Applicants' clamed invention, and with regards to claim 7, Applicants' also submit that the combination of

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Olah and Pavley and Asai does not teach Applicants' claimed invention. Thus, Applicants' respectfully submit that the Examiner has not proven prima facie obviousness for claim 1 and 7, and therefore dependent claim 7 which depends from claim 1 should be allowed.

Responsive to Examiner's rejection of claims 9, 21, 23, 27 and 29, Applicant's response is similar to Applicant's response made for corresponding claims 1 and 7. Therefore, Applicants respectfully submit that the Examiner has not proven prima facie obviousness for claims 1 and 7, and therefore corresponding claims 9, 21, 23, 27 and 29 should be allowed.

Conclusion

All of the currently pending claims are deemed to be patentable for the reasons discussed above.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims is respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment.

Respectfully submitted,

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